

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231*PL*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/287,631 04/07/99 EBY

J 03063.0396-0

EXAMINER

IM62/0328  
FINNEGAN HENDERSON FARABOW GARRETT  
& DUNNER  
1300 I STREET NW  
WASHINGTON DC 20005

KUHNS, A

ART. UNIT

PAPER NUMBER

1732

DATE MAILED:

03/28/00

*15*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.	09/287,631	
Applicant(s)	EBY ET AL.	
Examiner	KUHNS	
	Group Art Unit	1732

**—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—**

### **P r i d f r Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### **Status**

- Responsive to communication(s) filed on DEC 30, 1999 AND FEB. 18, 2000.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### **Disposition of Claims**

- Claim(s) 25 - 26 AND 33 - 46 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 25 - 26 AND 33 - 46 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### **Application Papers**

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

### **Priority under 35 U.S.C. § 119 (a)-(d)**

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

### **Attachment(s)**

- Information Disclosure Statement(s), PTO-1449, Paper No(s). 11, 12  Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

## Office Action Summary

Art Unit: 1732

1. Claims 25-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 25, "said curing step" lacks antecedent basis and in claim 26, "said softening step" lacks antecedent basis. Clarification is required.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 25-26 and 33-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese reference 1-110123. The Japanese reference discloses or suggests the basic claimed process including (1) chemically embossing at least a portion of a first layer and (2) conducting a mechanical embossing step (using an embossing roll). The Japanese reference does not explicitly state that a wear layer is applied before foaming or chemical embossing but does state at page 7, lines 14-18 of a translation provided by Applicants that a surface treated layer may be formed on the foamed layer before the foaming process and it would have been obvious to one of ordinary skill in the art that the surface treated layer would have been subject to wear prior to the foamed layer due to its relative position in the formed laminate. It would also have been obvious to one of ordinary skill in the art that the surface treated layer or second layer, when present, would be subject to mechanical embossing at the time when the first layer or foamed layer was being embossed. The Japanese reference also suggests a relatively greater depth for the chemical

Art Unit: 1732

embossment relative to the mechanical embossment by stating that the foamable layer foamed almost eight times (page 7, line 10) while preferably using a roll having a depth of unevenness as small as 0.8 mm (page 7, line 9), with the foamable layer being laminated on a base material at a preferred thickness of up to 0.25 mm (page 4, line 17).

Regarding claim 39, the aspect that the layer formed is a floor covering is essentially a statement of an intended use for the article molded rather than a manipulative step used to distinguish "method" claims over prior art. The Japanese reference teaches softening prior to mechanical embossing, as in claim 40, at page 8, lines 5-7. The particular softening temperature range, as in claims 26 and 42, would have been readily determined through routine experimentation by one of ordinary skill in the art, taking care to re-heat to a temperature below the decomposition temperature of the foaming agent. The first layer in the process of the Japanese reference is a foamed layer and it is submitted that the second layer has characteristics of a wear layer, as in claim 34, as discussed previously.

The Japanese reference teaches or suggests a mechanical embossing depth within the ranges of claims 35-36 and 43-44 at page 7, line 10 of the translation. It is submitted that some foam cells are not crushed in the practice of the process of the Japanese reference, as in claims 37 and 45, based on the suggested depth of unevenness of the rolls relative to the thickness of a foamed layer which may be expanded up to eight times, and the figures in this reference illustrate portions that are chemically embossed which are not mechanically embossed, as in claims 38 and

Art Unit: 1732

46. It is also submitted that the foamable layer of the Japanese reference is subject to expansion and curing together, as in claim 25.

4. Applicants' arguments filed December 30, 1999 have been fully considered but they are not persuasive. Applicants' arguments are considered to be moot by the examiner based on the revised grounds of rejection introduced in this Office action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allan Kuhns whose telephone number is (703) 308-3462. The examiner can normally be reached on Monday to Thursday from 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Silbaugh, can be reached on (703) 308-3829. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

*Allan R. Kuhns*

ALLAN R. KUHNS  
PRIMARY EXAMINER

GROUP 1302 AU 1732

3-27-00